

REMARKS/ARGUMENTS

In response to the Final Office Action mailed November 10, 2004, Applicants propose to amend their application and request reconsideration in view of the proposed amendments and the following remarks. Claim 8 is proposed to be amended, no claims have been added, and no claims were cancelled without prejudice so that claims 1, 2, 5-9 and 12-15 remain pending. No new matter has been introduced.

Claims 8-9 and 12-15 were rejected under 35 U.S.C. § 112, second paragraph. Applicants have amended claim 8 to correct the minor deficiency. Accordingly, reconsideration and withdrawal of your rejection is respectfully requested.

Claims 1-2 and 5-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 1 025 813 to Wilson et al. (Wilson) in view of U.S. Patent Number 6,689,120 to Gerdts (Gerdts). Claims 1, 2, 5-9 and 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,726,712 to Raeder-Devens et al (Raeder) in view of U.S. Patent Number 6,689,120 Gerdts. Claims 1, 2 and 5-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,287,329 to Duerig et al. (Duerig) in view of Gerdts. Claims 8, 9 and 12-15 were rejected as being unpatentable over Duerig in view of Gerdts and Raeder. These rejections are respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference

(or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In *re Vaeck*, 947 F.2d, 488, 20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

Wilson discloses a delivery apparatus for a self-expanding stent. The device comprises and outer sheath, an inner shaft and a self-expanding stent. The outer sheath comprises an outer polymeric layer, an inner polymeric layer and a wire reinforcing layer between the inner and outer layers. It is suggested that the reinforcing layer may comprise wires having circular and non-circular cross-sections.

Gerdts discloses a reduced profile, catheter based delivery system. The delivery system includes a reinforcing structure having at least one elongate flexible structural strand having a substantially uniform non-circular transverse profile. The structural strand is incorporated into a tubular body between the outside surface and the inside surface. The strands having a width dimension at least twice the thickness dimension. In one preferred embodiment, the strand has a

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width of 0.003 inches and a thickness of 0.0007 inches. The specification also discloses a number of different profiles.

Raeder-Devens discloses a delivery device for a self-expanding stent. The device comprises an outer sheath, an inner shaft, and a self-expanding stent. The sheath including an inner layer having stainless steel braiding disposed therein. The braiding is circular in cross-section.

Duerig discloses a delivery apparatus for a self-expanding stent. The apparatus comprises an outer sheath, a self-expanding stent and a readily removable member disposed along the outer sheath. This member being configured to prevent the outer sheath from expanding prior to delivery of the stent.

None of the references, whether taken alone or in combination disclose a delivery apparatus for a self-expanding stent that comprises stainless steel wire that is substantially rectangular and has a width of 0.003 inches and a height of 0.001 inches. The dimensions of the Gerdt's device are a width of 0.003 and a thickness of 0.0007. The height or thickness in the present is an order magnitude less than in Gerdt's. This significant difference provides a better balance between profile and strength. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Applicants would be willing to interview the present case if the Examiner so desires. Accordingly, the Examiner is invited to call the undersigned at (732) 524-2518 if such a call would facilitate the prosecution of this application.

The Reply/Amendment raises no new issues and places the application in form for allowance. Therefore, entry is proper and earnestly solicited.

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Respectfully submitted,

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